

## REMARKS

Applicant has carefully reviewed the office action mailed July 26, 2006 and offers the following remarks.

Applicant wishes to thank the Examiner for indicating that claims 3, 4, 22, and 23 would be allowed if rewritten in independent form. Applicant reserves the right to rewrite claims 3, 4, 22, and 23 at a later time.

Claims 1, 2, 5-21, and 24-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0160932 A1 to Yegoshin (hereinafter “Yegoshin”) in view of U.S. Patent No. 6,633,636 to McConnell et al. (hereinafter “McConnell”). Applicant respectfully traverses. To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. MPEP § 2143.03. For the Patent Office to combine references in an obviousness rejection, the Patent Office must prove there is a suggestion to combine the references. For the Patent Office to prove that there is a suggestion to combine the references, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). If the Patent Office cannot establish obviousness, the claims are allowable.

Before addressing the rejection, Applicant provides a brief summary of the invention to put the distinctions between the claimed invention and the cited references in proper context. The present invention relates to a communication environment where calls are established with a single mobile terminal through either a cellular network or a packet network via a local wireless adaptor, which is capable of wirelessly communicating with the mobile terminal. As such, the mobile terminal may facilitate traditional cellular calls via the wireless network, or packet-based calls via the local wireless adaptor. The local wireless adaptor and mobile terminal communicate via a local wireless interface, and as such, communications via the packet network through the local wireless adaptor are only possible within a limited communication zone supported by the local wireless adaptor. When the mobile terminal is involved in a call and within the communication zone of the local wireless adaptor, the packet-based call is facilitated via the local wireless adaptor. As the mobile terminal approaches the outer limits of the communication zone, the existing call to the mobile terminal is transferred to another connection which is

established through the cellular network. As such, the call may continue via the cellular network when local wireless communications are no longer available or not desired by the user.

Claims 1, 20, and 39 are all directed to transitioning a call with a mobile terminal from a packet network to a cellular network, wherein the call is initially established between a remote device and the mobile terminal via a local wireless adaptor coupled to a packet-based network. In addition, each of claims 1, 20, and 39 require a determination that the call should be transferred to the mobile terminal via the cellular network. In contrast, neither Yegoshin nor McConnell are directed to **transitioning** a call with a mobile terminal from a packet network to a cellular network, wherein the call is **initially established** between a remote device and the mobile terminal via a local wireless adaptor coupled to a packet-based network. In addition, neither Yegoshin nor McConnell, alone or in combination, teach or suggest determining that the call should be transferred to the mobile terminal via the cellular network.

The Patent Office asserts that Yegoshin discloses, at paragraphs 0049 and 0050, transitioning a call with a mobile terminal from a packet network to a cellular network, wherein the call is initially established between a remote device and the mobile terminal via a local wireless adaptor coupled to a packet-based network, and determining that the call should be transferred to the mobile terminal via the cellular network. Applicant respectfully traverses. Yegoshin discloses a dual mode device that is capable of both cellular phone communication and communication on an IP-LAN. A temporary IP address is assigned to a dual mode device that logs onto a LAN, where the IP address is associated at a PSTN-connected server on the LAN with the cell phone number of the dual mode device. The IP server notifies the PSTN-connected server when a device logs on to a LAN and provides a destination number for the IP server. Cell calls directed to the device are then redirected to the IP server and to the device connected to the LAN (Yegoshin, Abstract). When the dual mode device is logged onto the IP network, calls are routed via the PSTN to the IP network. However, calls from known origination numbers may be routed to the local cell network and received in local cell phone mode (Yegoshin, paragraph 0049). In another example in Yegoshin, a call that arrives at a switch is held to check via the mobile switching center to see if the user is in the area. The call is routed through the PSTN to the IP switch. If the dual mode phone is not logged on to the IP network, then the call is routed to the appropriate cellular service area, based on the actual cell phone number (Yegoshin, paragraph 0050). Notably, all of this routing takes place before the call is initially established to

the dual mode device. Thus, Yegoshin determines whether to route a call through the IP-LAN or through the cellular network when the call is incoming. As such, Yegoshin does not teach or suggest a call being initially established between a remote device and the mobile terminal via a local wireless adaptor coupled to a packet-based network and then transitioning the call to a cellular network. McConnell fails to cure the deficiencies of Yegoshin in this regard. Therefore, claims 1, 20, and 39 are patentable.

Likewise, because Yegoshin determines whether to route a call through the IP-LAN or through the cellular network when the call is incoming, Yegoshin does not teach or suggest “determining the call should be transferred to the mobile terminal via the cellular network,” as required by the claimed invention. The Patent Office cites to paragraphs 0049 and 0050 of Yegoshin as allegedly teaching this element (Office Action mailed July 26, 2006, p. 2). Applicant has reviewed these paragraphs and finds no teaching or suggestion of determining the call that was initially established via a local wireless adaptor coupled to a packet-based network should be transferred to the mobile terminal via the cellular network. The cited sections of Yegoshin, as discussed above, disclose determining where to route an incoming call. However, Yegoshin does not disclose or suggest determining to transfer an already established call to the mobile terminal via the cellular network. Thus, Yegoshin fails to teach this element as well. McConnell fails to cure the deficiencies of Yegoshin in this regard. Therefore, claims 1, 20, and 39 are patentable for this additional reason.

Claims 1, 20, and 39 are patentable for still a further reason. Claims 1, 20, and 39 all require the initiation of a first connection between a first media gateway and the mobile terminal via the cellular network. The Patent Office cites to Figures 2-3, telephone switch 31, IP switch 35, MSC 34, PSTN 36, and to paragraphs 0049 and 0050 of Yegoshin as allegedly teaching this element. Applicant initially notes that it is unclear what the Patent Office is equating to the claimed media gateway. Applicant respectfully submits that neither the telephone switch 31 nor the IP switch 35 is a media gateway. A media gateway acts as a translation unit between disparate telecommunications networks. Thus, a telephone switch in the PSTN or an IP switch on a LAN cannot be a media gateway. Accordingly, Yegoshin does not teach or suggest “initiating a first connection between a first media gateway and the mobile terminal via the cellular network,” as required by the claimed invention. McConnell fails to cure the deficiencies

of Yegoshin in this regard. Therefore, claims 1, 20, and 39 are patentable for this additional reason.

Finally, Yegoshin fails to disclose “effecting a transfer of the call to the first connection between the first media gateway and the mobile terminal,” as recited in claims 1, 20, and 39. The Patent Office admits this, but asserts that McConnell teaches this element in Figures 4-6, in col. 2, line 37 to col. 3, line 7, and in col. 8, lines 22-48. Applicant respectfully traverses. The cited portions of McConnell disclose a system where hotel customers may be provided with a cellular phone along with a landline phone in their room. When an incoming call is received at the private communications system of the hotel, the private system checks to see if the landline extension and the cellular phone are available to take the call. If both are available, the private communications system rings both phones and connects the incoming call to the phone that is answered first (McConnell, col. 2, lines 37-56). Accordingly, customers can be assigned a single number, and a private communications system can connect a call to that customer using the single number regardless of which phone the customer currently has (McConnell, col. 3, lines 12-17). Notably, there is no teaching of transferring a call that was initially established to the mobile terminal via a local wireless adaptor coupled to a packet-based network to a connection established between a media gateway and the mobile terminal via the cellular network. Instead, McConnell teaches ringing both landline and mobile phones and connecting the call to which phone is answered. There is never a transfer of a call in McConnell. Thus, McConnell does not teach or suggest “effecting a transfer of the call to the first connection between the first media gateway and the mobile terminal,” as recited in claims 1, 20, and 39.

In addition, Applicant notes that the STP 30 of McConnell is not equivalent to the claimed media gateway. This is a separate reason that McConnell does not teach transferring a call to the first connection between the first media gateway and the mobile terminal. Since McConnell does not teach or suggest the element for which it is cited, and the Patent Office admits that Yegoshin does not teach this element, the combination cannot teach or suggest the element. Thus, claims 1, 20, and 39 are patentable for this additional reason.

Moreover, the Patent Office has failed to support its stated motivation to combine Yegoshin and McConnell. The Patent Office states that it would have been obvious to combine Yegoshin and McConnell “in order to provide certain enhanced services in accordance with the call routing instruction received from the service control point.” (Office Action mailed July 26,

2006, p. 3). However, the Patent Office has failed to provide any actual evidence to support the stated motivation. Without such actual evidence, the stated motivation is improper. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Since the stated motivation is improper, the combination is improper, making the rejection improper. In addition, the stated motivation does not compel the combination. There is no evidence that Yegoshin would need or want “certain enhanced services in accordance with the call routing instruction received from the service control point.” In fact, Yegoshin doesn’t even disclose a service control point. Thus, one of ordinary skill in the art would not look to combine McConnell with Yegoshin to get “certain enhanced services in accordance with the call routing instruction received from the service control point.” Therefore, the proposed combination is improper for this additional reason.

In light of the above arguments, the combination of Yegoshin and McConnell is improper, and also fails to teach or suggest each and every element of claims 1, 20, and 39. Thus, claims 1, 20, and 39 are allowable. Claims 2 and 5-19 depend from claim 1 and include all the limitations of claim 1, and are therefore patentable for at least the same reasons. Claims 21 and 24-38 depend from claim 20 and include all the limitations of claim 20, and are therefore patentable for at least the same reasons. Applicant also reserves the right to argue the separate patentability of the dependent claims based on their further limitations at a later time, should it be necessary.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant’s representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By: 

John R. Witcher, III  
Registration No. 39,877  
P.O. Box 1287  
Cary, NC 27512  
Telephone: (919) 654-4520

Date: October 26, 2006  
Attorney Docket: 7000-313